

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/804,093 03/12/01 SCOTT

R 6511-C1-11-E

EXAMINER

HM12/0712

WARNER-LAMBERT COMPANY  
201 TABOR ROAD  
MORRIS PLAINS NJ 07950

SEIDLECK, B

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

07/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.  
**09/804,093**

Applicant(s)  
**Scott et al.**

Examiner  
**Brian K. Seidleck**

Art Unit  
**1615**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-33 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-33 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

***Continuing Data***

1. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. Brief Description of the Several Views of the Drawings: A reference to and brief description of the drawings as set forth in 37 CFR 1.74. Applicants are requested to give a brief description of the drawing.

***Claim Objections***

4. Claims 15-33 are objected to under 37 CFR 1.75 c) as being in improper multiple dependent form. See MPEP § 608.01(n).
5. Claims 4-5 recite "the the" at line 1 of each claim.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 5, 7, 9, 19 and 13-33 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “consisting of” language, however claims 5, 7, 13-33 improperly recite additional limitations.

Claim 9 recites limitations within parentheses. The claim is indefinite because it is unclear whether these limitations are part of the claim.

Claim 19 recites abbreviations. The entire spelling is required for purposes of clarity.

9. Claims 1-2 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The metes and bounds of the claims is unascertainable in view of the terms “non-

pig” and “non-bovine” and “poultry” and “plants”. The specification provides no examples to define what forms of gelatin are derived from poultry or plants.

10. Claim 32 provides for the use of gelatin solutions, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 32 is rejected under 35 U.S.C. § 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 U.S.C. § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by Soper (U.S. Pat. No. 5,603,952).

Soper reads on a gelatin composition containing fish gelatin and a setting system. See Cols. 1-2.

***Claim Rejections - 35 U.S.C. § 103***

13. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Soper (U.S. Pat. No. 5,603,952); Shen (U.S. Pat. No. 5,683,717); Wolf et al (U.S. Pat. No. 4,876,105, collectively "Wolf"); and Yamamoto et al (U.S. Pat. No. 5,756,123, collectively "Yamamoto").

The examiner interprets the present invention as a gelatin composition, comprising a gelatin of non-bovine and non-porcine origin and an additional setting system. The compositions are useful for containers for unit dosage forms for agrochemicals, seeds, herbs, foodstuffs, dyestuffs, pharmaceuticals, or flavoring agents. Caplets can be encapsulated by the gelatin

composition or an aqueous solutions of the compositions can be used in the manufacturing of hard gelatin capsules, by way of dip moulding processes.

Fish gelatin coatings for food and/or flavor crystals are disclosed by Soper. See Cols. 1-2 and Example 1. Specifically, gum arabic (hydrocolloid) and fish gelatin are combined to provide a coating for food or flavor crystals. Id. Similarly, Wolf discloses gelatin compositions for food comprising a blend of gelatin, gellan gum (hydrocolloid) and cations such as potassium, calcium, magnesium or sodium. See Cols. 1-2 and tables 1-3. Wolf discloses that the hardness of the gelatin composition may be regulated by the cations. See Col. 5, lines 34-57. Shen teaches gelatin coatings for medicines comprising gelatin, lecithin (sequestering agent), plasticizer (triacetin), colorants. See Cols. 2-3 and Example 1. Yamamoto teaches capsule coatings comprising the combination of hydrocolloid (carrageenan) and cations (potassium or calcium) as gelling agents. See abstract. Conventional coloring agents may be used and dip moulding techniques to produce capsules is disclosed. See Col. 4.

The prior art discloses coatings of a variety of gelatin types. Fish, bovine and porcine-type gelatin are all used in coatings from food to medicines. They are recognized as functional equivalents in the absence of evidence to the contrary. As to the combination of hydrocolloid and cation as the setting system, the prior art teaches that both are used as gelling agents and therefore one of ordinary skill in the art would have been motivated to combine gelatin with the claimed setting system to produce a more stable coating composition.

*Correspondence*

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Brian K. Seidleck** whose telephone number is **(703) 305-4448**. The examiner can normally be reached **Monday, Tuesday, Thursday, Friday from 6:30am to 5:00pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Thurman K. Page**, can be reached on **(703) 308-2927**. The official fax numbers for Technology Center 1600 are **(703) 305-3592** and **(703) 308-4556**. The unofficial fax number is **(703) 308-7924**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center receptionist** whose telephone number is **(703) 308-1235** or **(703) 308-1234**.

Brian K. Seidleck  
Patent Examiner  
July 10, 2001

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
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